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REMARKS

The Office action dated September 14, 2007 and the cited references have been carefully considered.

Status of the Claims

Claims 4, 7, 9-12, 20, and 21 are pending.

Claims 4, 7, 9-12, 20, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 6,274,133 (hereinafter referred to as "the '133 Patent") in view of US Patent 5,928,606 (hereinafter referred to as "the '606 Patent").

Applicant respectfully traverses these rejections for the reasons set forth below.

Claim Rejection Under 35 U.S.C. § 103(a)

Claims 4, 7, 9-12, 20, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the '133 Patent in view of the '606 Patent. Applicant respectfully traverses the rejection of these claims because a combination of the '133 Patent and the '606 Patent does not teach or suggest all of the limitations of each of claims 4, 7, 9-12, 20, and 21.

To establish a *prima facie* case of obviousness, the prior art references (or references when combined) must teach or suggest **all the claim limitations**. M.P.E.P. § 2142 (Rev. 5, Aug. 2006). Moreover, even when all the elements are present, an apparent reason to combine the known elements (limitations) in the fashion presently claimed should be made explicit by the fact finder. *KSR Int'l Co. v. Teleflex Inc.*, 2007 U.S. Lexis 4745, 36-37; 127 S. Ct. 1727, 1741 (2007). It can be important to identify the reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does because merely demonstrating that each of the claimed invention's elements was known in the prior art is not sufficient to establish a *prima facie* case of obviousness. *Id.*; see also *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665 (Fed. Cir. 2000).

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The '133 Patent discloses a method for rewetting hydrogel contact lenses. The cationic cellulosic polymers of a solution of this reference are used for the prevention of lipid deposition on the lens surface by complexing therewith. See column 5, lines 15-17. The solution may contain a comfort wetting agent such as glycerine, propylene glycol, monosaccharide, or disaccharide. Column 7, lines 16-21. Nowhere does this reference disclose, teach, or suggest that glucose or α -methyl gluco-pyranoside to be used with polyquaternium-10 to provide preservative (preventing growth of microorganism) efficacy, as claimed in the instant claims. This reference does not show and cannot be used to fairly infer that such a combination has any preservative efficacy. The Examiner has not articulated any reason for her assertion, which was so clearly required in *KSR*. *KSR*, 127 S. Ct. at 1741, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.") Here, neither does the reference disclose specifically glucose and α -methyl gluco-pyranoside nor does the Examiner explain how one can infer specifically these compounds from a mere mention of "monosaccharide" from scores of possible monosaccharides.

Furthermore, the '133 Patent never contemplates and, thus, cannot suggest that a combination of polyquaternium-10 and glucose or α -methyl gluco-pyranoside can serve as a preservative because the '133 Patent teaches that biguanides, alexidine, chlorhexidine or similar materials are used as disinfectants (preservative function not even disclosed).

The '606 Patent discloses a contact lens-disinfecting device, a surface of which is impregnated with a disinfectant such as biguanide, chlorhexidine, or benzakonium chloride. Column 4, lines 26-27 and column 6, lines 19-22. This reference emphasizes its advantage in that the disinfectant is fixed to the treating device, and therefore is not transferred to the contact lens and subsequently to the eye, "causing trouble to the eyes." Column 3, lines 6-22. Further, this reference distinguishes itself from conventional liquid agents. Column 3, lines 33-34. Thus, this reference at least teaches away from using liquid disinfectants, let alone discloses preservatives in solution, as recited in the instant claims. Such a teaching away renders this reference improper for combination with the '133 Patent as a basis for claim rejection under 35 U.S.C. § 103(a). *U.S. v. Adams*, 383 U.S. 39, 52 (1966) (Known

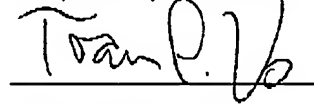
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disadvantages in old devices which would naturally discourage the search for new inventions are probative in determining the unobviousness of these new inventions.)

Since the Examiner has not provided well-articulated and convincing reasoning for the alleged obviousness of the claims and since it is not proper to combine the references in view of the teaching away by the '606 Patent, claims 4, 7, 9-12, 20, and 21 are not rendered obvious by the '133 Patent in view of the '606 Patent.

In view of the above, it is submitted that the claims are patentable and in condition for allowance. Reconsideration of the rejection is requested. Allowance of the claims at an early date is solicited.

Respectfully submitted,



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